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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/436,092    11/08/99    ANDIDEH    E    043290.P3955

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QM12/0927

EXAMINER

MCDONALD, S

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

09/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/436,092**

Applicant(s)  
**Andideh et al.**

Examiner  
**Shantese McDonald**

Group Art Unit  
**3723**



☒ Responsive to communication(s) filed on Nov 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 27-53 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 27-53 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Priority*

1. It is noted that this application appears to claim subject matter disclosed in prior copending Application No. 08/997,293, filed 12/23/97. A reference to the prior application must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.
2. Applicant is advised that should claim 28 be found allowable, claim 35 will be rejected under 35 U.S.C. 101 as being a substantial duplicate thereof.
3. Applicant is advised that should claim 29 be found allowable, claim 43 will be rejected under 35 U.S.C. 101 as being a substantial duplicate thereof.
4. Applicant is advised that should claim 36 be found allowable, claim 43 will be rejected under 35 U.S.C. 101 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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*Claim Rejections - 35 USC § 112*

**27-47**

5. Claims ~~25-47~~ are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the applicant is attempting to define the structure of the claim based on the work and the work is not a part of the claimed invention.

It is also noted, in reference to claims 30, 37, and 44, there is no such thing as a "one-sided-triangle", it is suggested that the one-sided-triangle be referred to as a right triangle or an isosceles triangle.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 27-30, 34-37, 41-44,48,50 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by James et al.

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James et al. teaches a polishing pad, 10, having a plurality of u-shaped grooves, 18,20, the grooves having an increased depth, and a decreased depth, and increased width, and a decreased width, an increased density, and an increased density, (fig. 1).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 31-33,38-40,45-47,49,51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over James et al.

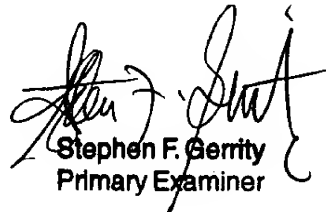
James et al. teaches all the limitations of the claims except for the depth and the width being adjusted within the range of 1-90% of the pad thickness, the width being within the range of 1-100 mils, and the groove density being adjusted within the range of 2-50 grooves/inch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the grooves of James et al. with the depth and the width being adjusted within the range of 1-90% of the pad thickness, the width being within the range of 1-100 mils, and the groove density being adjusted within the range of 2-50 grooves/inch, since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art.

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*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burke et al. and Morgan, III et al. were cited to show other examples of grooved polishing pads.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shantese McDonald whose telephone number is (703) 308-8722.

  
Stephen F. Gerrity  
Primary Examiner

S.L.M.

September 19, 2000